

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

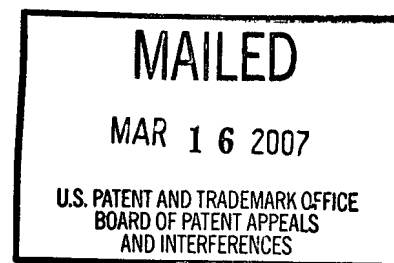
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte JAMES H. McLAUGHLIN

Appeal 2006-3210
Application 09/964,143
Technology Center 1600

ON BRIEF



Before ADAMS, GRIMES, and LINCK, *Administrative Patent Judges*.
LINCK, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal from final rejection under 35 U.S.C. § 103(a) of all pending claims in the above-identified application, filed September 25, 2001.¹ We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

STATEMENT OF THE CASE

“The invention relates to an improvement in topical compositions for conditioning the skin . . . in the form of a substantially stable, extrudable paste or cream.” Specification (“Spec.”) 1. The compositions are in the

¹ The real party in interest is Crabtree & Evelyn, Ltd.

form of “a stable suspension of a mildly abrasive, particulate matter . . . effective to cleanse the skin . . . in addition to conditioning the skin.” *Id.*

According to the specification, compositions “for delivering hydrophobic skin benefit agents to the skin are known in the prior art. . . . Further, it is known to prepare [such compositions] in the form of emulsions or creams.” *Id.* Finally, “exfoliating compositions also are well known in the art.” *Id.* at 2. However, again according to the specification, “there still exists a need for stable compositions containing emollient material in the form of an extrudable paste or cream that are suitable for cleansing the skin and depositing a film . . . such that the skin has a non-greasy after-feel.” *Id.* at 3.

Claims 3, 6, 7, 33, and 39-43 stand rejected under 35 U.S.C. § 103(a). “For each ground of rejection . . . , the claims rejected as a group shall stand or fall together.” Appeal Brief Under 37 CFR § 41.37(c) (dated Nov. 11, 2005) (“Br.”) 9.

The Examiner has rejected claims 3, 6, 33, and 40-43 based on U.S. Patent Nos. 6,042,815 (issued March 28, 2000) (“Kellner”) and 5,360,824 (issued Nov. 1, 1994) (“Barker”). Representative claim 40 reads:

40. A cosmetic exfoliating composition for use in cleansing and conditioning the skin of the hands, face, heels/knees/elbows and/or the body of a human being in the form of a[n] extrudable paste or cream that comprises:

(A) 40% to 60% by weight of emollient material consisting of a major proportion of emollient oil selected from the group consisting of animal oils, vegetable or plant derived oils, hydrocarbon oils, silicone oils and mixtures thereof and a minor proportion of an emollient hydrophobic compound selected from the group consisting of C12 –C18 fatty acids,

C12 - C18 fatty alcohols, C12 - C18 fatty esters, Shea butter, lanolin or a lanolin derivative, lecithin and mixtures thereof;

(B) a water-soluble surface active agent selected from the group consisting of anionic, nonionic, amphoteric, zwitterionic and cationic surfactants in a proportion selected from the range of 0.4% to 8.0% by weight, said proportion being effective to deposit a skin softening amount of emollient material on the treated skin without a greasy after-feel when said composition is rinsed from skin with water and the skin is dried;

(C) a calcium or magnesium salt of a C14 - C18 monocarboxylic acid wherein the weight ratio of emollient material to said monocarboxylic acid salt is in the range of 4:1 to 2.5:1, said proportion being adequate to produce a composition in the form of a stable, extrudable paste or cream;

(D) 10% to 45% by weight of a non-irritating, mildly abrasive, skin compatible, particulate material that is effective to cleanse and lubricate the skin without abrading the skin, said particulate material including a mixture of 8% to 20% by weight of a starch material selected from the group consisting of starches and enzyme or acid hydrolyzed starches with another particulate material selected from the group consisting of sodium chloride, pumice, talc and vegetable flour; and

(E) 0% to 10% by weight of water;

said composition being effective to cleanse, soften, smooth and moisturize the skin when the composition is applied to and massaged into the skin, thereafter rinsed from the skin with tepid water and the skin is dried.

The Examiner has rejected claims 7 and 39 based on Kellner, Barker, and U.S. Patent No. 6,153,208 (“McAtee”). Claim 39 is representative of this group and reads:

39. A composition according to Claim 40 wherein the emollient oil is macadamia seed oil, the water-soluble surface active agent is sodium cocoyl N-methyl taurate, the water-insoluble monocarboxylic acid salt is calcium stearate and the particulate material is a mixture of starch and sodium chloride and the resultant composition is substantially anhydrous.

ISSUES ON APPEAL

Claim 40

Relevant to the patentability of claim 40, the Examiner concluded “it would have been prima facie obvious . . . to make a composition with the particular percentages of each and every component[]” in claim 40 because Kellner discloses each component in ranges that overlap or encompass those claimed. Final Office Action (mailed 3/23/04) (“FOA”) 3; Examiner’s Answer (“Answer”) 3-4. Further, according to the Examiner, the “employment” of the claimed ingredients would have been “obvious since they are known to be useful” and would simply involve “a selection from amongst equally suitable material” disclosed in Kellner. FOA 3; Answer 4.

Appellant contends his claimed invention would not have been obvious over Kellner and Barker because: (1) the sodium, magnesium, and calcium salts of stearic acid are not equivalents in Kellner’s cosmetic stick compositions, as sodium stearate is soluble in water and calcium and magnesium stearate are not (Br. 11-14 & Affidavits Under 37 CFR § 1.132);

(2) “Kellner’s compositions are in form of solid or stick . . . and Appellant’s compositions are in form of cream or extrudable paste” (*id.* at 9-10);
(3) “Kellner’s compositions are used to deliver pigments to the skin . . . and, optionally, to moisturize the skin . . . ; whereas Appellant’s compositions are effective to cleanse the skin . . . and condition the skin by depositing fatty matter on the skin” (*id.* at 10); (4) “Kellner’s concentration of surfactant is controlled to facilitate wetting of pigments being delivered to the skin . . . ; whereas Appellant’s surfactant concentration is controlled to deliver a controlled amount of emollient material to the skin” (*id.*); and, finally,
(5) Kellner’s “stick compositions . . . contain ‘appreciable amounts of water’ . . . ; whereas Appellant’s compositions contain 0% to 10% by weight water.”
Id.

With respect to claim 40, given the record before us, we frame the issue to be decided as follows:

Would Appellant’s claimed “cosmetic exfoliating composition” comprising recited ranges of (A) an emollient oil and emollient hydrophobic compound, (B) a water-soluble surfactant, (C) a calcium or magnesium salt of a C14 – C18 monocarboxylic acid, and (D) a particulate material have been obvious in view of the teachings of Kellner and Barker?

Claim 39

Relevant to claim 39, the Examiner concluded that the teachings of Kellner, combined with those of Barker (disclosing an anhydrous cream containing sodium chloride) and of McAtee (disclosing use of sodium cocoyl methyl taurate) would have rendered claim 39 obvious to the skilled artisan.

Appellant contends Barker and McAtee do not address the deficiencies of Kellner (noted *supra* at pp. 4-5). Appellant further contends McAtee is non-analogous art. Br. 18.

Thus, with respect to claim 39, in addition to the issue identified above with regard to claim 40, the disputed issue before us is:

Did the Examiner appropriately combine McAtee with Kellner and Barker, or is McAtee non-analogous art?

FINDINGS OF FACT

Claim 40

Kellner discloses each component of claim 40 in ranges that encompass or overlap those claimed: (A) 0.1-30% “emollient oil,” 0.01-20% “oil phase gelling agent,” e.g., a fatty acid such as lanolin; (B) 0.1-20% “surfactant;” (C) 0.1-20% “carboxylated salt gelling agent,” e.g., calcium or magnesium stearate;² (D) 0.1-50% “particulates,” e.g., starch and talc; and (E) 5-95% water. Col. 1, l. 59 to col. 2, l. 3. See also col. 9 (emollient oils); col. 2 (oil phase gelling agents); cols. 11 & 12 (surfactants); col. 2, ll. 23-63 (carboxylated salt gelling agents); and col. 19 (particulates). Appellants do not appear to dispute this finding. See Br. & Reply *passim*.

Appellant conducted several experiments to show calcium stearate is not “equivalent” to sodium stearate. See Appellant’s two affidavits *passim*.

² The claimed ratio of emollient material to calcium or magnesium salt is 4:1 to 2.5:1. We calculate 40% and 60% “emollient material” would require 10 to 16% and 15 to 24% “calcium or magnesium salt,” respectively, substantially overlapping with Kellner’s disclosed 0.1 to 20% carboxylated salt.

More specifically, he substituted calcium stearate for sodium stearate in Kellner's Examples 1 and 2B and found he did not obtain a solid stick as he did with sodium stearate. Affidavit Two Under 37 CFR § 1.132 ("Aff. Two"), ¶¶ 4 & 5.

Appellant's experiments were not designed with Kellner's broader teachings in mind and did not consider the skill of the artisan in this field—skill that would apply routine experimentation to adjust the other components when a water-insoluble carboxylated salt, such as calcium stearate, is used in place of or along with a water-soluble salt such as sodium stearate. Further, only a single amount of calcium stearate was used rather than several amounts spanning Appellant's claimed range. Thus, we find the proffered showing is not commensurate in scope either with the claimed invention or with the prior art teachings.

The following findings respond to Appellant's five contentions (*see supra* at p. 5):

1. Contrary to Appellant's first contention, Kellner does not teach sodium, calcium and magnesium stearate are "equivalent." Instead Kellner teaches that the three salts are suitable for use in his compositions. Col. 2, ll. 57-60. ("Examples of gelling agents that may be used . . . are sodium, potassium, aluminum, magnesium, or calcium salts of stearic, behenic, caprylic, tallowic, tallic, cocoic, or lauric acids"). Neither does Kellner teach nor suggest that calcium and magnesium stearates are water soluble. In fact, Kellner teaches his "carboxylated salt gelling agent" can be "water soluble *or* water insoluble," although he prefers a water-soluble one formed with a metallic cation such as sodium. Col. 2, ll. 35-39 (emphasis added).

Consistent with these teachings, in Example 1, Kellner includes both water insoluble aluminum stearate and water-soluble sodium stearate. Col. 22, ll. 17-45. Thus, as the Examiner found, Kellner teaches calcium and magnesium stearate are suitable for use in the disclosed invention.

2. With respect to the form of the composition, while Kellner primarily teaches “sticks or solids,” use of “cream forms” is expressly disclosed “to deliver certain consumer benefits.” Col. 2, l. 17. Furthermore, as Appellant admits (Br. 17), Barker discloses a paste, one of Appellant’s claimed forms. Finally, one of ordinary skill working in this art would have been aware of such alternative formulations. *See, e.g.*, Spec. 1 (compositions “in the form of . . . creams” are known).

3. While Kellner’s particulates can be pigments, they are not so limited. Col. 19, l. 36 to col. 20, l. 25. As Appellant recognizes, one “object” of Kellner’s is a formulation “capable of moisturizing the skin.” Col. 1, ll. 39-41. Further, Kellner expressly includes particulates recited in Appellant’s claim 40, i.e., “starch” and “talc.” Col. 19, l. 52. We find such components would “cleanse the skin . . . and condition the skin by depositing fatty matter” (Br. 10), just as Appellant’s starch and talc would do. This would be particularly true, given the substantial overlap of the claimed and disclosed ranges, i.e., 10 to 45% and 0.1 to 50%, respectively.

4. Kellner discloses using surfactants “to wet the pigments and assist in stabilizing the emulsion compositions” in a range of “0.001-20%, preferably 0.01-10%, more preferably 0.05-8% by weight Suitable surfactants . . . include nonionic, amphoteric, zwitterionic, and cationic surfactants.” Col. 11, l. 65 to col. 12, l. 4. Appellant claims a surfactant

“selected from the group consisting of anionic, nonionic, amphoteric, zwitterionic and cationic surfactants in a proportion selected from the range 0.4% to 8% by weight.” See claim 40. Given the significant overlap of these surfactants, we find Kellner’s surfactants would be “effective to deposit a skin softening amount of emollient material” as claimed.

5. With respect to the amount of water disclosed in Kellner, Kellner expressly teaches a range of water between 5% and 95%, overlapping with Appellant’s claimed range of 0% to 10%. Col. 2, l. 3. While *one* of Kellner’s objects is to “formulate stable, pigmented cosmetic sticks and solids containing appreciable levels of water” (col. 1, ll. 43-45), the reference’s teachings and other objectives go much further. Thus, Kellner teaches the skilled artisan to vary the amount of water between 5% and 95%, depending upon the type of formulation the artisan is seeking.

Claim 39

In addition to the above findings, the following findings are relevant to the patentability of claim 39.

McAtee relates to “a substantially dry, disposable, personal cleansing article useful for both cleansing and conditioning the skin.” Col. 1, ll. 20-22. Objects of McAtee’s invention include “to provide methods of cleansing and consistently conditioning the skin” (col. 4, ll. 13-15) and “to provide methods of consistently providing deposition of conditioning agents and other active ingredients” (col. 4, ll. 17-19). Kellner’s objects include providing “compositions which are capable of moisturizing the skin.” Col. 1, ll. 39-41. Barker provides “an improved means of cleansing the skin and reducing skin wrinkles without irritating the skin or clogging its pores.”

Col. 1, ll. 44-47. Barker recognizes moisturizing is necessary to prevent wrinkles. Col. 1, ll. 15-16 (“Wrinkling occurs as moisture and skin oils are removed”).

All of the components recited in claim 39 are expressly disclosed in Kellner, Barker, and/or McAtee, except “macadamia seed oil.”

McAtee discloses “preferred anionic lathering surfactants” (col. 20, ll. 1-2), including Appellant’s claimed “sodium cocoyl methyl taurate.” Col. 20, ll. 10-11.

Barker discloses a “skin-cleansing and wrinkle-reducing cream [which] employs an oleaginous base [and] a plurality of water-soluble, skin-abrading granules or particles which are of a material which does not irritate the skin.” Col. 1, ll. 52-61. Barker’s “water-soluble, skin abrading . . . particulates” include Appellant’s claimed “sodium chloride.” Col. 2, ll. 59-64. “Preferably, the base is an edible oil and/or petroleum jelly.” Col. 1, ll. 61-62. The edible oil is “most preferably vegetable oil such as sunflower seed oil, peanut oil, corn oil, canola oil or the like.” Col. 2, ll. 33-36. Barker’s formulations are anhydrous. *See, e.g.*, Examples I & II (col. 3, l. 41 to col. 4, l. 9).

Similar to Barker, Kellner discloses vegetable oil, such as “coconut oil, cottonseed oil, linseed oil . . . , olive oil, palm oil . . . , rapeseed oil, soybean oil, sunflower seed oil, walnut oil, and the like.” Col. 10, ll. 48-55.

The skilled artisan would have recognized Appellant’s claimed macadamia seed oil to be a member of the group of oils contemplated by Barker’s and Kellner’s language “and the like.” *See, e.g.*, U.S. Patent No. 6,033,647 (col. 5, ll. 19-25) equating such oils (“oils of plant” useful as

“cosmetic oils” include coconut oil, macadamia oil . . . , soybean oil . . . , corn oil, rapeseed oil, sunflower oil, cottonseed oil, [and] olive oil”).

PRINCIPLES OF LAW

Claim Interpretation

“‘Comprising’ is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claims.” *Genentech, Inc. Chiron Corp.*, 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997) (quoting *In re Baxter*, 656 F.2d at 686, 210 USPQ at 802).

“A long line of cases confirms that one cannot establish novelty by claiming a known material by its properties.” *In re Crish*, 393 F.3d 1253, 1258, 73 USPQ2d 1364, 1368 (Fed. Cir. 2004). When “the prior art evidence reasonably allows the PTO to conclude that a claimed feature is present in the prior art, the evidence ‘compels such a conclusion if the applicant produces no evidence or argument to rebut it.’ *Spada*, 911 F.2d at 708 n. 3.” *Crish*, 393 F.3d at 1259, 73 USPQ2d at 1369. The court in *Crish* was addressing a § 102 issue. However, “the inherent teaching of a prior art reference . . . arises both in the context of anticipation and obviousness.” *In re Napier*, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995).

Obviousness Under 35 U.S.C. § 103(a)

“A claimed invention is unpatentable if the differences between it and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the pertinent art.” *In re Kahn*, 441 F.3d 977, 985, 78 USPQ2d 1329, 1334

(Fed. Cir. 2006). “Precedent requires that to find a combination obvious there must be some teaching, suggestion, or motivation in the prior art to select the teachings of separate references and combine them to produce the claimed combination.” *In re Johnston*, 435 F.3d 1381, 1384, 77 USPQ2d 1788, 1790 (Fed. Cir. 2006). However, an “explicit teaching that identifies and selects elements from different sources and states that they should be combined in the same way as the invention at issue, is rarely found in the prior art. As precedent illustrates, many factors are relevant . . . such as the field of the specific invention, the subject matter of the references, the extent to which they are in the same or related fields of technology, the nature of the advance made by the applicant, and the maturity and congestion of the field.” *Id.* at 1385, 77 USPQ2d at 1790.

“Obviousness does not require absolute predictability. . . . Only a reasonable expectation that the beneficial result will be achieved is necessary to show obviousness.” *In re Merck & Co.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986).

The fact that a specific embodiment “is taught to be preferred is not controlling, since all disclosures of the prior art, including unpreferred embodiments, must be considered.” *In re Lamberti*, 545 F.2d 747, 749, 192 USPQ 278, 280 (CCPA 1976), *quoted with approval in Merck & Co. v. Biocraft Labs*, 874 F.2d 804, 807, 10 USPQ2d 1843, 1846 (Fed. Cir. 1989). *See also In re Inland Steel Co.*, 265 F.3d 1354, 1360-61, 60 USPQ2d 1396, 1402 (Fed. Cir. 2001).

The “existence of overlapping or encompassing ranges shifts the burden to the applicant to show that his invention would not have been

obvious.” *In re Peterson*, 315 F.3d 1325, 1330, 65 USPQ2d 1379, 1383 (Fed. Cir. 2003). *See also In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

Rebuttal Evidence

In challenging the suitability of a teaching, it must be shown that “one of ordinary skill in the art, making adaptations within the skill of the art, could not have successfully carried out” the disclosed process. *Lamberti*, 545 F.2d at 750 n.2, 192 USPQ at 281 n.2.

Analogous Art

“The analogous-art test requires that the Board show that a reference is either in the field of the applicant’s endeavor or is reasonably pertinent to the problem with which the inventor was concerned” *Kahn*, 441 F.3d at 986, 78 USPQ2d at 1335-36.

ANALYSIS

Claim 40

Considering the factors relevant to an obviousness determination and the fact-findings above, we conclude the Examiner has made a prima facie case that it would have been obvious to one of ordinary skill in the art to make Appellant’s claimed “cosmetic exfoliating composition” in view of the cited prior art.

Due to Appellant’s use of “comprising” language, his claims do not exclude additional components, such as those disclosed in Kellner. Thus, in view of Kellner’s teachings, it would have been obvious to either substitute or additionally include a water-insoluble stearate, i.e., calcium or magnesium stearate, in Kellner’s compositions and use routine experimentation to adjust

the remaining components to obtain a suitable form of cosmetic. In this regard, we note Appellant claims broad ranges of components which would also require use of routine skill in the art to arrive at a suitable formulation.

We recognize Appellant's claims contain such functional language as "for use in cleansing and conditioning" and "said proportion being effective to deposit a skin softening amount of emollient material . . . without a greasy after-feel." See claim 40. However, without some showing that the closest prior art compositions would not achieve these sought-after properties (or Appellant's claimed composition would yield unexpected results), we conclude these claimed properties would be present in the cited prior art, or prior art combination.

Appellant has attempted to show Kellner would be inoperative if calcium or magnesium stearate is used in Kellner's formulations. We conclude Appellant's showing is not sufficient to establish inoperability and does not address the reference's broader teachings. Kellner discloses the suitability of these two stearates but does not state they are 1:1 equivalent with water-soluble sodium stearate. Thus, the skilled artisan following Kellner's suggestion to use calcium or magnesium stearate, alone or in combination with a water-soluble stearate, would have used routine experimentation and applied the skill in the art to make a suitable cosmetic formulation containing one of these stearates. The fact that calcium stearate cannot be directly substituted for sodium stearate without any application of skill or variation of other ingredients does not establish inoperability.

Further, Kellner's preference for water-soluble sodium stearate does not negate the reference's teachings regarding calcium or magnesium

stearate. A skilled artisan in the cosmetic field would have recognized all Kellner's teachings and applied them accordingly to obtain useful cosmetic compositions.

Finally, Appellant has not attempted to show unexpected results due to his claimed ranges. Thus, the Examiner's prima facie case, based on Kellner's overlapping or encompassing ranges has not been rebutted.

Claim 39

Considering our above fact-findings and relevant caselaw, we conclude McAtee is analogous art. In fact, McAtee is both in Appellant's field of endeavor, i.e., the cosmetic field, and is reasonably pertinent to the problem with which Appellant is concerned, i.e., cleansing and conditioning, or moisturizing, the skin. Thus, the Examiner appropriately relied upon McAtee to supplement the disclosures of Kellner and Barker.

CONCLUSIONS

We affirm the Examiner's § 103(a) rejection of claim 40 in view of Kellner and Barker. These references disclose all the components of claim 40 in ranges that overlap or encompass the claimed ranges.

We affirm the Examiner's § 103(a) rejection of claim 39 in view of Kellner, Barker and McAtee. These references are appropriately combined and disclose or suggest all the elements of claim 39.

Lacking any argument regarding their separate patentability, we also affirm the rejection of claims 3, 6, 7, 33, and 41-43 pursuant to 37 CFR § 41.37(c)(1)(vii).

No time period for taking any subsequent action in connection with
this appeal may be extended under 37 CFR § 1.136(a)(1)(iv) (2006).

AFFIRMED

Donald E. Adams)	
Administrative Patent Judge)	
)	
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)	BOARD OF PATENT
Eric Grimes)	
Administrative Patent Judge)	APPEALS AND
)	
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